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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,964	01/16/2007	Florence Henry	C 2925 PCT/US	8591
23657	7590	08/09/2010	EXAMINER	
FOX ROTHSCHILD LLP 997 Lenox Drive, Bldg. #3 Lawrenceville, NJ 08648			TATE, CHRISTOPHER ROBIN	
			ART UNIT	PAPER NUMBER
			1655	
			NOTIFICATION DATE	DELIVERY MODE
			08/09/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,964	<b>Applicant(s)</b> HENRY ET AL.	
	<b>Examiner</b> Christopher R. Tate	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13,15,17-19,21,22,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13,15,17-19,21,22,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>0610</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02 July 2010 has been entered.

Claims 13, 15, 17-19, 21, 22, 25, and 26 are presented for examination on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18, 19, 22, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18 and 19 are rendered vague and indefinite by the respective phrases "wherein said cosmetic treatment provides at least one effect selected from ..." and "wherein the cosmetic treatment provides a whitening effect or a lightening effect" because it is unclear if the recited effects are attempting to define an alternative embodiment to the "anti-ageing effect" recited in independent claim 15, or if the effects recited in claims 18 and 19 are in addition to this "anti-ageing effect".

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Claims 22 and 25 are rendered vague and indefinite by steps (a) and (b) of the recited preparation method - i.e., step (a) recites "extracting the leaves ... with a solvent selected from ... to form a solution of the extract in the solvent" However, this phrase is unclear and ambiguous because typically in the herbal extract art, the solvent itself is the solution [i.e., the final phrase of step (a) recites "to form a solution of the extract in the solvent" which gives the impression that the "solution of the extract" is a distinct entity within the "solvent"]; and step (b) recites "removing the solvent from the solution to recover said extract" (which reinforces the concept of the extraction solution and solvent being separable entities). If Applicant is attempting to define extracting the plant material by placing the plant material in an extraction solvent, removing the plant material therefrom, then removing the extract solvent therefrom (e.g., preparing a dry extract preparation thereof), it is suggested that the claims reflect such steps (however, it is cautioned that no new matter be added to the claim language which is not fully supported by the teachings of the instant disclosure).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 15, 17-19, 21, 22, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the International Cosmetic Ingredient Dictionary and Handbook (9th ed, 2002

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- IDS reference) in view of the admitted state of the art, and further in view of Schneider (US 6,184,247), and Chiej (MacDonald Encyclopedia of Medicinal Plants, 1984), with evidence provided by Chevallier (Encyclopedia of Herbal Medicine, 2000)\*.

The cited International Cosmetic Ingredient Dictionary and Handbook beneficially teaches that *Castanea sativa* leaf extract is a well known herbal extract used in the cosmetic art as a skin-conditioning agent (see description of this plant extract on page 276 of this IDS reference). This document does not expressly teach the inclusion of auxiliaries or additives such as those instantly claimed therein. However, it should be noted that it is notoriously well recognized in the art that essentially all cosmetics comprise auxiliaries and/or additives such as many of those instantly claimed (e.g., surfactants, emulsifiers, fats, waxes, antimicrobial agents, preservatives, perfumes, and/or dyes, etc.) therein - which Applicants readily admit are commonly used in the art for cosmetic purposes (see, e.g., page 6, 6th full paragraph, of the instant specification).

Schneider beneficially teaches topical cosmetic compositions useful for treating skin (including for treating aging skin having wrinkles and/or age spots) which comprise, or may comprise, skin conditioners and/or plant extracts such as witch hazel as active ingredients therein as well as various auxiliaries and additives from among those instantly claimed (e.g. waxes, oils, emulsifiers, surfactants, perfumes, thickeners, and/or preservatives (see entire document including, e.g., col 1, lines 16-24; col 3, lines 31-49; col 4, lines 5-12; col 5, lines 29-35; col 6, lines 61-67; col 7, lines 6-64; col 8, lines 7-67; col 9, lines 9-21; col 10, Table 4, and col 11, Table 5).

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Chiej beneficially teaches that *Castanea sativa* leaves have been used in the prior art as a substitute for witch hazel (see # 72 - herbal description of *Castanea sativa*) and teaches a cosmetic hair shampoo comprising an extract (e.g., in the form of an infusion or other fluid extract) of *Castanea sativa* leaves. As evidenced by Chevallier, infusions are prepared via placing the plant/herbal material in a strainer, then placing the strainer in hot/boiling water for 5-10 minutes, removing the strainer (with the plant/herbal material inside) to produce the extract infusion (see page 291 of Chevallier). Further, as evidenced by Chevallier, witch hazel is notoriously well known in the prior art to be used cosmetically to topically treat such ailments as skin abrasions, facial veins, varicose veins, and hemorrhoids, including in the form of a lotion or ointment (see page 104 of Chevallier).

It would clearly have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include one or more auxiliaries and/or additives from among those instantly claimed within a cosmetic composition comprising the well known cosmetic skin conditioning agent *Castanea sativa* leaf extract (as beneficially taught by the cited International Cosmetic Ingredient Dictionary and Handbook) therein, since such auxiliaries and/or additives are routinely incorporated within such cosmetic compositions and, as readily admitted by Applicants are well known in the art for such cosmetic purposes, as discussed above.

It would also have been obvious to one of ordinary skill in the art at the time the claimed invention was made to further include the well known cosmetic skin conditioning agent *Castanea sativa* leaf extract (as beneficially taught by the cited International Cosmetic Ingredient Dictionary and Handbook) within the topical cosmetic compositions taught Schneider because Schneider beneficially discloses that skin conditioners as well as plant extracts such as witch

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hazel may be included as active ingredients therein, and because Chiej beneficially teaches that *Castanea sativa* leaves (which Chiej also beneficially teaches can be effectively extracted via conventional infusion/fluid extraction thereof) have been used in the prior art as a substitute for witch hazel, making the incorporation of such a *Castanea sativa* leaf extract an obvious equivalent substitution for the witch hazel extract disclosed by Schneider therein. If not expressly taught, please note that the instantly claimed functional effects (anti-ageing and/or other recited skin effects such as those recited in instant claims 18 and 19) would be intrinsic upon topical application to the skin and/or scalp of a cosmetically-treated subject. The adjustment of particular conventional working conditions (e.g., determining an appropriate amount of an infused *Castanea sativa* leaf extract to incorporate therein and/or using a conventional extraction solvent to prepare such a *Castanea sativa* leaf extract as well as removing the solvent therefrom following extraction so as to form a concentrated extract) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

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Claims 13, 15, 17-19, 21, 22, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiej (MacDonald Encyclopedia of Medicinal Plants, 1984) in view of Grand (US 3,849,548) and the admitted state of the art, with evidence provided by Chevallier (Encyclopedia of Herbal Medicine, 2000)\*.

Chiej teaches that a hair shampoo comprising an extract (e.g., in the form of an infusion or other fluid extract) of *Castanea sativa* leaves is well known in the art to impart a golden gleam to the hair, and that *Castanea sativa* leaves have been used in the prior art as a substitute for witch hazel (see # 72 - herbal description of *Castanea sativa*). As evidenced by Chevallier, infusions are prepared via placing the plant/herbal material in a strainer, then placing the strainer in hot/boiling water for 5-10 minutes, removing the strainer (with the plant/herbal material inside) to produce the extract infusion (see page 291 of Chevallier). Further, as evidenced by Chevallier, witch hazel is notoriously well known in the prior art to be used cosmetically to topically treat such ailments as skin abrasions, facial veins, varicose veins, and hemorrhoids, including in the form of a lotion or ointment (see page 104 of Chevallier).. Thus, the infusion of *Castanea sativa* leaves (within such a hair shampoo and/or cosmetic) as reasonably taught/suggested by Chiej reads upon the instantly claimed *Castanea sativa* leaf extract and preparatory method thereof. Chiej does not appear to expressly teach the inclusion of one or more of the auxiliaries/additives instantly claimed within such a hair shampoo or cosmetic product comprising *Castanea sativa* leaf extract therein.

Grand teaches cosmetic hair/skin care products including in the form of a cleansing hair (shampoo) and/or skin composition (containing surfactants therein) which may further comprise other adjuvants/substances therein such as plant extracts including so to enhance the cosmetic



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properties thereof (see entire document including col 4, lines 56-61 and col 9, lines 34-41).

Further, as readily admitted by Applicants, the instantly claimed auxiliaries/additives are well known in the art to be common for cosmetic purposes.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to provide a hair shampoo comprising an effective amount of a *Castanea sativa* leaf extract (such as in the form of an infusion) as an active cosmetic ingredient therein with respect to functioning to impart a golden gleam to the hair (as beneficially taught by Chief) and/or to provide a cosmetic skin care composition comprising an effective amount of a *Castanea sativa* leaf extract so as to function effectively as a substitute for witch hazel when topically applied to an area of skin in need thereof - including within a conventional hair (shampoo) and/or skin care product such as one comprising one or more surfactants therein and/or other admittedly well known conventional cosmetic auxiliaries/additives therein, including a hair (shampoo) and/or skin care product in which plant extracts can be incorporated therein (for their known cosmetic purpose), such as beneficially taught by Grand. Please note that the instantly claimed functional effect (anti-ageing and/or other recited skin effects such as those recited in instant claims 18 and 19) would be intrinsic upon topical application to the skin and/or scalp of a cosmetically-treated subject. The adjustment of particular conventional working conditions (e.g., determining an appropriate amount of an infused *Castanea sativa* leaf extract to incorporate therein and/or using a conventional extraction solvent to prepare such a *Castanea sativa* leaf extract as well as removing the solvent therefrom following extraction so as to form a concentrated extract) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

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From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

\* Please note that the Chevallier reference is not being cited as art within the USC 103 rejections above, but instead is being cited to show an inherent feature with respect to preparing a plant infusion (e.g., from *Castanea sativa* leaves) such as reasonably taught/suggested by the Chiej reference, as well as to show the well known prior art cosmetic uses of witch hazel (as discussed within the USC 103 rejections above).

Applicants' arguments concerning the USC 103 rejection immediately above have been carefully considered but are not deemed to be persuasive of error in the rejection. Applicants argue that there is no teaching, suggestion, or motivation in the combination of Chiej in view of Grand, with evidence provided by Chevallier that would lead one skilled in the art at the time of the invention to a method of treating a human body with a composition comprising *Castanea sativa* leaf extract and at least one auxilliary and/or additive adapted for topical treatment of the human body, wherein an anti-ageing effect would be expected or observed. However, for the reasons fully set forth above (wherein the rejection was over Chiej in view of Grand and the admitted state of the art, with evidence provided by Chevallier), the instantly claimed functional effects (including the recited anti-ageing effect) would be intrinsic upon topical application to the skin and/or scalp of a cosmetically-treated subject. It should be noted that the skin of all mammals, including human, are in a constant state of aging from the moment of birth (until death). Accordingly, the topical application of such a cosmetic composition to the scalp or skin

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of any human (or other mammalian) subject would intrinsically provide the instantly recited anti-ageing effect.

With respect to the USC 103 rejection immediately above, Applicants have argued and discussed references individually (including within the arguments presented in Applicants' previous reply) without clearly addressing the combined teachings (including the admitted state of the art). It must be remembered that the references (and admitted state of the art) are relied upon in combination and are not meant to be considered separately as in a vacuum. It is the combination of all of the cited and relied upon art which make up the state of the art with regard to the claimed invention. Applicants' claimed invention fails to patentably distinguish over the state of the art represented by the references (and admitted state of the art).

### **Conclusion**

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher R. Tate/  
Primary Examiner, Art Unit 1655